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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,550	09/03/2003	Howard Hooper	100110809-3	5097

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
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EXAMINER
GLEITZ, RYAN M

ART UNIT	PAPER NUMBER
2852	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,550

Applicant(s)

HOOPER, HOWARD

Examiner

Ryan Gleitz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 23-26, 29-34, 37 and 38 is/are rejected.
- 7) ☒ Claim(s) 27, 28, 35 and 36 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9, 10, 13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hodoshima et al. (USPN 5,182,601).

Hodoshima et al. disclose a converter for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge. The cartridge, toner handling device (1), serves as either a developing device or a cleaning device (Col. 6, lines 30-38). A developing device is non waste-residue toner cartridge, and a cleaning device is a waste-residue collecting toner cartridge. Figure 2 illustrates a toner storing member (Col. 2, line 24), which reads on a waste-residue collection site. Cleaning roller (12; col. 9, line 34) reads on a waste-residue remover.

Regarding claim 2, an opening, as shown in figure 2, positioned proximate a photo conductor drum (11) is disposed within the cartridge, and the remover (12) is operably associateable with the photo conductor drum (11).

Regarding claim 3, the waste-residue collection site is a waste-residue hopper.

Regarding claims 9 and 10, the toner storing member (Col. 2, line 24) reads on means for collecting waste-residue from the photo conductor drum (11), and the cleaning roller (12) reads

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on means for removing waste-residue from the photo conductor drum (11) and directing the waste-residue into the means for collecting waste-residue.

Regarding claims 14 and 15, the toner handling device serving as either a developing device or a cleaning device also reads on the method for converting a non waste-residue collecting toner cartridge to a waste-residue collecting toner cartridge.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16, 23-25, 29-34, 37, and 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3, 7-9, 11-13, and 15 of U.S. Patent No. 6,621,996. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application includes a method for converting a toner cartridge from a cleanerless toner cartridge to a conventional toner cartridge, and it would have been obvious to one of ordinary skill in the art that a cleanerless toner cartridge is equivalent to a non waste-residue collecting toner cartridge. A cleanerless toner cartridge or a toner cartridge without a cleaner has no waste residue to collect. A non-waste

residue collecting toner cartridge operates in the same way, performs the same function, and achieves the same result as a cleanerless toner cartridge.

Claims 1-4, 6, 8-11, and 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,654,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent includes a housing. It would have been obvious to one of ordinary skill in the art that the toner cartridge of the pending application would include a housing. All toner cartridges must include a housing.

Claims 23-26, and 29-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,654,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent does not include the waste-residue converter at least partially within the housing. It would have been obvious to one of ordinary skill in the art that the waste-residue converter would be within the housing. If the waste-residue converter is part of the toner cartridge, it must be at least partially within the housing of the toner cartridge.

Allowable Subject Matter

Claims 27, 28, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 23-26, 29-34, 37, and 38 would be allowable if the above nonstatutory double patenting rejection is overcome.

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Claims 4-8, 11, 12, and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the above nonstatutory double patenting rejection is overcome.

Response to Arguments

Applicant's arguments, see pages 9 and 10 of the amendment, filed 03 September 2003, with respect to the rejection(s) of claim(s) 1-16 under Sato et al. (USPN 5,870,654) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection of claims 1-3, 9, 10, 13, and 15 is made in view of Hodoshima et al. (USPN 5,182,601).

Contact Information

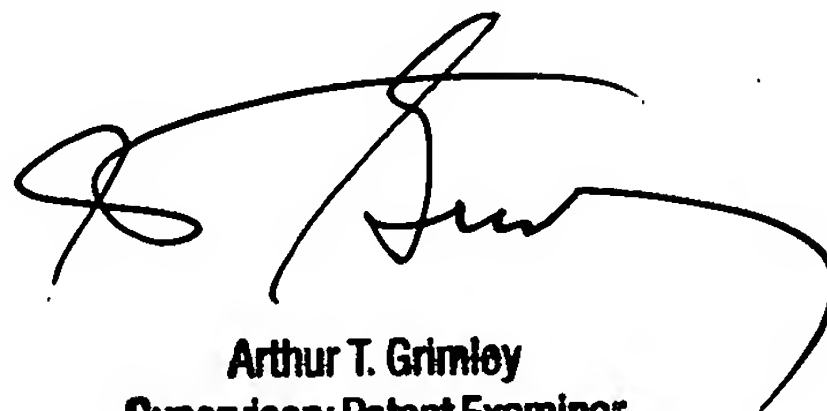
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Gleitz whose telephone number is (571) 272-2134. The examiner can normally be reached on Monday-Friday between 8:00AM and 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on (571) 272-2136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RK
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